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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/753,134	12/29/2000	Gary L. Shanklin	659/766	1798

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EXAMINER

SALVATORE, LYNDIA

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/753,134

Applicant(s)

SHANKLIN, GARY L.

Examiner

Lynda M Salvatore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 23-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's request for reconsideration, Paper No. 9 as been entered. Upon careful consideration, Applicant's arguments are not found persuasive to patently distinguish the claims over the prior art of record for reasons set forth herein below.

### ***Election/Restrictions***

2. Applicant's election without traverse of Group I, claims 1-22, in Paper No. 9 is acknowledged. Claims 23-34, Group II, are withdrawn as non-elected.

### ***Claim Rejections - 35 USC § 103***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claim 1-3 and 5-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rothe et al., US 4,738,847 in view of Goulet et al., WO 99/37860.

Applicant argues that the Examiner has not established a *prima facie* case of obviousness under 35 U.S.C. 103 and further asserts that there is no motivation to combine the above references. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is the position of the Examiner that a clear motivation to combine

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references exists since the analogous art Rothe et al., and Goulet et al., both teach a multiply absorbent article. Recall, that Rothe et al., discloses a multi-ply absorbent article comprising a virucidal composition confined to the inner layer of the product (Abstract). Preferably the absorbent article comprises three plies, wherein the inner or middle layer further comprises a virucidally effective amount of a virucidal composition (Column 1, lines 22-35). Rothe et al., teaches applying the virucidal composition to the inner ply layer to reduce any irritation that may result from having the virucidal composition present on the surface of the article (Column 2, lines 10-20). The Examiner acknowledges that Rothe et al., lacks a teaching to the siloxane composition present on at least one outer ply, however, Goulet et al., cures this deficiency by applying an amine-modified polysiloxane to the outer surfaces of a three-ply tissue product. Goulet et al., further teaches that the application of an amine-modified polysiloxane to the surfaces of the tissue products imparts softness and a degree of hydrophobicity, which prevent wet through of liquids during use. To that end, it is the position of the Examiner that it would have been obvious to one having ordinary skill in the art, having knowledge of these prior art to disclosures at the time the invention was made to apply the amine-modified polysiloxane composition of Goulet et al.; to the multi-ply virucidal absorbent article of Rothe et al. The modification for this argument is found in the explicit teachings of Goulet et al., which teaches imparting softness and hydrophobicity through the application of an amine-modified polysiloxane. As such since the article is employed as a facial tissue these features are easily recognizable as important to the product of Rothe et al.

5. Claims 1-8,13,14,18,19,20-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Rothe et al., (as discussed above), in view of Roe et al., US 5,635,191.

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Applicant makes the same argument as recited above in section 4. In response to Applicant's argument that there is no suggestion to combine the references, the Examiner reiterates the points made above.

***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lynda M Salvatore whose telephone number is 703-305-4070. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

lsf

May 19, 2003



TERREL MORRIS  
SUPERVISORY PATENT EXAMINER  
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